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| 10/811,824 | 03/30/2004 | Yoshiaki Mimura | WEN-0032 | 3065 |

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RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

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| EXAMINER |
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PINKNEY, DAWAYNE

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| ART UNIT | PAPER NUMBER |
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2873

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

24

Office Action Summary

Application No.

10/811,824

Applicant(s)

MIMURA ET AL.

Examiner

DaWayne A. Pinkney

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/30/2004, 09/10/2004 and 12/30/2004.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 03/30/2004 was considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7-8, 10-12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Miwa (US 5, 841, 502).

Regarding **claim 7**, Miwa discloses, an ophthalmic apparatus comprising:

an intraocular pressure measurement part including a blowing unit which blows a fluid to a cornea via a nozzle for measuring intraocular pressure of an eye of an examinee (Column 1, lines 13-19, Column 3, lines 63-67 and Column 4, line 1);

an eye characteristic examination part in which an examination optical system, which photo-receives reflection light from the eye for examining an eye characteristic, is arranged (Column 1, lines 9-19);

a main body in which the measurement part and the examination part are arranged (Column 3, lines 21-23 and 1 of Fig. 1);

a mobile base on which the main body is movably arranged (Column 4, lines 11-15 and 3 of Fig. 1);

a first moving unit, having a movement operating member, which moves the mobile base with respect to the eye in a working distance direction through operation of the operating member (Column 3, lines 32-42);

a second moving unit, which moves the main body with respect to the mobile base in the working distance direction (Column 3, lines 32-42, Column 4, lines 11-15 and 3 of Fig. 1);

a third moving unit which moves the measurement part with respect to the main body in the working distance direction (Column 3, lines 32-42 and Column 3, lines 55-60);

a detection unit, which detects that the mobile base is located at a rear reference position in a direction away from the eye to emit a detection signal (Column 1, lines 23-27);

mode switching means for emitting a switching signal to switch between a first mode for examining the eye characteristic and a second mode for measuring the intraocular pressure (inherent); and

a movement control unit, which controls driving of the third moving unit so as to move the measurement part near to the eye, based on the detection signal of the detection unit and the switching signal from the first mode to the second mode (Column 1, lines 41-45, Column 1, lines 65-67 and Column 2, lines 1-17).

Regarding **claim 8**, Miwa discloses, the ophthalmic apparatus according to claim 7, further comprising an input switch, provided to the operating member, which inputs a signal for starting at least one of measurement by the measurement part and examination by the examination part (deemed as inherent),

wherein the movement control unit judges the signal inputted by the input switch as the switching signal when the detection signal is emitted from the detection unit (Column 9, lines 41-64).

Regarding **claim 10**, Miwa discloses, Miwa discloses, an ophthalmic apparatus comprising:

an intraocular pressure measurement part including a blowing unit which blows a fluid to a cornea via a nozzle for measuring intraocular pressure of an eye of an examinee (Column 1, lines 13-19, Column 3, lines 63-67 and Column 4, line 1);

an eye characteristic examination part in which an examination optical system, which photo-receives reflection light from the eye for examining an eye characteristic, is arranged (Column 1, lines 9-19);

a main body in which the measurement part and the examination part are arranged (Column 3, lines 21-23 and 1 of Fig. 1);

a first moving unit which moves the main body with respect to the eye in the working distance direction (Column 3, lines 32-42, Column 4, lines 11-15 and 3 of Fig. 1);

a second moving unit which moves the measurement part with respect to the main body in the working distance direction (Column 3, lines 32-42 and Column 3, lines 55-60);

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a movement control unit, which controls driving of the second moving unit so as to move the measurement part near to the eye based on the switching signal from the first mode to the second mode, and controls the driving of the second moving unit so as to move the measurement part away from the eye based on the switching signal from the second mode to the first mode (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

Regarding **claim 11**, Miwa discloses, the ophthalmic apparatus according to claim 10, wherein the movement control unit controls driving of the first moving unit so as to move the main body away from the eye based on the switching signal from the first mode to the second mode (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

Regarding **claim 12**, Miwa discloses, the ophthalmic apparatus according to claim 10, further comprising:

a detection optical system, arranged in the main body, for detecting each alignment state of the examination part and the measurement part with respect to the eye in the working distance direction (Column 1, lines 23-27); and

judging means for judging appropriateness of the alignment state of the examination part in the first mode and appropriateness of the alignment state of the measurement part in the second mode according to a different reference working distance, based on a detection result obtained by the detection optical system (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

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Regarding **claim 14**, Miwa discloses, the ophthalmic apparatus according to claim 10, further comprising a working distance detection unit, which detects a working distance of the measurement part with respect to the eye (Column 1, lines 65-67 and Column 2, lines 1-17),

wherein the movement control unit controls the driving of the second moving unit so as to stop movement of the measurement part in a direction near to the eye when the detected working distance is less than a reference working distance (Column 1, lines 65-67 and Column 2, lines 1-17).

Regarding **claim 15**, Miwa discloses, the ophthalmic apparatus according to claim 10, wherein the movement control unit controls driving of the first moving unit so as to position the main body at a reference position, based on the switching signal (Column 1, lines 65-67 and Column 2, lines 1-17).

Regarding **claim 16**, Miwa discloses, the ophthalmic apparatus according to claim 10, further comprising an informing unit, which informs a movement state of the measurement part (Column 9, lines 49-57).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa (US 5, 841, 502) in view of Yasuhisa (JP 2005-160546).

The cited primary reference Miwa teaches an ophthalmic apparatus comprising:

an intraocular pressure measurement part including a blowing unit which blows a fluid to a cornea via a nozzle for measuring intraocular pressure of an eye of an examinee (Column 1, lines 13-19, Column 3, lines 63-67 and Column 4, line 1);

an eye characteristic examination part in which an examination optical system, which photo-receives reflection light from the eye for examining an eye characteristic, is arranged (Column 1, lines 9-19);

a first moving unit, which moves the main body with respect to the mobile base in the working distance direction (Column 3, lines 32-42, Column 4, lines 11-15 and 3 of Fig. 1);

a second moving unit which moves the measurement part with respect to the main body in the working distance direction (Column 3, lines 32-42 and Column 3, lines 55-60);

mode switching means for emitting a switching signal to switch between a first mode for examining the eye characteristic and a second mode for measuring the intraocular pressure (inherent); and

a movement control unit, which controls driving of the second moving unit based on the switching signal (Column 1, lines 41-45, Column 1, lines 65-67 and Column 2, lines 1-17).

The cited primary reference does not teach a reflection member, having a reflection surface, which is arranged insertably and removably between the eye and the nozzle;

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a third moving unit, which performs insertion and removal of the reflection member between the eye and the nozzle; and

the movement control unit controls the third moving unit based on the switching signal.

The added secondary reference, Yasuhisa teaches, a reflection member, having a reflection surface, which is arranged insertably and removably between the eye and the nozzle (Page 3, Paragraph 0011, lines 9-10 and Fig. 2);

a third moving unit, which performs insertion and removal of the reflection member between the eye and the nozzle (Page 5, Paragraph 0027, line 5 and Fig. 2); and

the movement control unit controls the third moving unit based on the switching signal (Page 3, Paragraph 0011, lines 1-10 and Fig. 2) for the benefit of this allows an image of a display condition for each inspection examined, without imposing time and effort (Paragraph 0006, lines 1-3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the third moving unit and the reflection member of Yasuhisa with the device of Miwa because the third moving unit and the reflection member of Yasuhisa allows an image of a display condition for each inspection examined, without imposing time and effort (Paragraph 0006, lines 1-3).

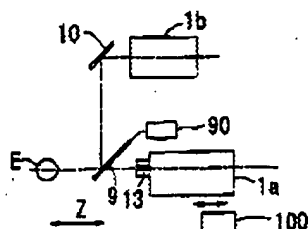


FIG. 2A

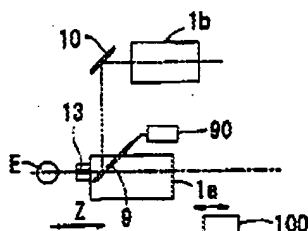


FIG. 2B

Regarding **claim 2**, Miwa discloses, The ophthalmic apparatus according to claim 1, wherein the movement control unit controls driving of the first moving unit so as to move the main body away from the eye, controls the driving of the second moving unit so as to move the measurement part near to the eye (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64),

In addition, Yasuhisa discloses, the movement control unit controls the driving of the third moving unit so as to remove the reflection member from between the eye and the nozzle, based on the switching signal from the first mode to the second mode (Page 3, Paragraph 0011, lines 1-10, Page 6, Paragraph 0029, lines 1-2 and Fig. 2).

Regarding **claim 3**, Miwa discloses, the ophthalmic apparatus according to claim 1, wherein the movement control unit controls the driving of the second moving unit so as to move the measurement part near to the eye, and controls the driving of the second moving unit so as to move the measurement part away from the eye, based on the switching signal from the first

mode to the second mode (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

In addition, Yasuhisa discloses, the movement control unit controls the driving of the third moving unit so as to remove the reflection member from between the eye and the nozzle, and controls the driving of the third moving unit so as to insert the reflection member between the eye and the nozzle, based on the switching signal from the second mode to the first mode (Page 3, Paragraph 0011, lines 1-10, Page 6, Paragraph 0029, lines 1-2 and Fig. 2).

Regarding **claim 4**, Yasuhisa discloses, the ophthalmic apparatus according to claim 3, further comprising:

a first image-pickup unit (Page 1, Paragraph 0005, lines 3-4), arranged in the examination part, which picks up an image of the eye via the reflection member (54 of Fig. 3);

a second image-pickup unit (Page 1, Paragraph 0005, lines 5-6), arranged in the measurement part, which picks up an image of the eye via the nozzle (25 of Fig. 3);

a display unit which displays a first image being the image picked up by the first image-pickup unit and a second image being the image picked up by the second image-pickup unit (Page 2, Paragraph 0005, lines 8-9); and

a display control unit, which controls the display unit so as to switch a display between the first image and the second image, based on movement of at least one of the measurement part and the reflection member (Page 2, Paragraph 0005, lines 8-17).

Regarding **claim 5**, Miwa discloses, the ophthalmic apparatus according to claim 3, further comprising a detection unit which detects at least one of whether the measurement part is

located at a measurement reference position (Column 1, lines 23-27) and whether the reflection member is located at an examination reference position (inherent),

wherein the movement control unit controls each driving of the second and the third moving units (inherent) based on a detection result obtained by the detection unit (Column 1, lines 23-27).

Regarding **claim 6**, Yasuhisa discloses, the ophthalmic apparatus according to claim 1, wherein the third moving unit moves the reflection member in a parallel direction to its reflection surface (Page 3, Paragraph 0011, lines 1-10 and Fig. 2)

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa (US 5, 841, 502) as applied to claim 7 above, further in view of Yasuhisa (JP 2005-160546).

The cited primary reference, Miwa, remains as applied to claim 7 above.

The cited primary reference does not teach a reflection member, arranged insertably and removably between the eye and the nozzle, for guiding the reflection light from the eye to the examination optical system;

a fourth moving unit, which performs insertion and removal of the reflection member between the eye and the nozzle,

wherein the movement control unit controls driving of the fourth moving unit so as to insert the reflection member between the eye and the nozzle, based on the detection signal of the detection unit and the switching signal from the first mode to the second mode.

The added secondary reference, Yasuhisa teaches, a reflection member, arranged insertably and removably between the eye and the nozzle, for guiding the reflection light from the eye to the examination optical system (Page 3, Paragraph 0011, lines 9-10 and Fig. 2);

a fourth moving unit, which performs insertion and removal of the reflection member between the eye and the nozzle (Page 5, Paragraph 0027, line 5 and Fig. 2),

wherein the movement control unit controls driving of the fourth moving unit so as to insert the reflection member between the eye and the nozzle, based on the detection signal of the detection unit and the switching signal from the first mode to the second mode (Page 3, Paragraph 0011, lines 1-10 and Fig. 2) for the benefit of this allows an image of a display condition for each inspection examined, without imposing time and effort (Paragraph 0006, lines 1-3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the fourth moving unit and the reflection member of Yasuhisa with the device of Miwa because the fourth moving unit and the reflection member of Yasuhisa allows an image of a display condition for each inspection examined, without imposing time and effort (Paragraph 0006, lines 1-3).

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa (US 5, 841, 502) as applied to claim 12 above.

The cited primary reference, Miwa, remains as applied to **claim 12 above**.

The cited primary reference does not teach a reference working distance in the first mode and the reference working distance in the second mode have a different permissible range.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the first and second modes have reference working distances that have a different permissible range because the second mode (intraocular pressure measurement) has to be closer

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to the eye in order for this measurement to work, this is due to the fact that the cornea will not deform enough for this measurement to be accurately performed.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following disclosures substantially teach an ophthalmic apparatus with an intraocular pressure measurement part, an eye characteristic examination part, moving units, mode switching means and a movement control unit:

Shimashita et al. (US 5, 822, 034)

Kobayashi (US 5, 299, 573)

Kohayakawa (US 5, 523, 808)

Yoshida et al. (US 6, 022, 108)

Isogai et al. (US 5, 909, 269)

Miyakawa et al. (US 6, 120, 444)

Masuda (US 5, 680, 196)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to DaWayne A. Pinkney whose telephone number is (571) 270-1305. The examiner can normally be reached on Monday-Thurs. 8 a.m.- 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DAP


Scott J. Sugarman
Primary Examiner